

REMARKS

Presently, claims 2-5, 10-12 and 28-42 are pending in the application. New dependent claims 41 and 42 have been added to recite additional features of the present invention. Support for new claims 41 and 42 may be found, for example, at page 14, line 8-23 and page 15, lines 4-30 of the specification. Accordingly, no new matter has been added by the foregoing amendments.

Descriptions of the prior art references discussed herein may be found in Applicant's previous Amendment, filed, September 30, 2005, which is incorporated herein by reference.

Prior Art Rejections – 35 USC § 103

The Examiner has rejected claims 10, 12, 28-33, 38 and 40 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,177,931 to Alexander *et al.* (“Alexander”) in view of U.S. Patent No. 6,002,393 to Hite *et al.* (“Hite”). The Examiner contends that Alexander teaches each and every element of the present invention, including reordering stored IPG ads in accordance with a displayed programming ad, but acknowledges that Alexander does not teach or suggest the memory structure of a queue and programming ads that are to be inserted in a programming avail. The Examiner further contends that Hite teaches these features, and concludes that it would have been obvious to combine the teachings of Hite with Alexander to result in Applicant's claimed invention. Applicant respectfully traverses this rejection.

Independent claim 28 recites:

A method of enhancing the effectiveness of IPG ads and programming ads in a television network environment, the method comprising:

(a) storing an IPG ad queue, the IPG ad queue containing an ordered list of IPG ads;

- (b) storing a programming ad queue, the programming ad queue containing an ordered list of programming ads to be inserted in a programming avail;
- (c) linking at least one IPG ad with at least one programming ad to form at least one IPG-programming ad combination;
- (d) displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad in the programming avail, wherein the IPG ads are displayed in accordance with the IPG ad queue; and
- (e) reordering the IPG ad queue in accordance with the displayed programming ad.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all of the claim limitations. *See MPEP 2143.* Applicant respectfully submits that independent claim 28 is patentable over the combination of Alexander and Hite at least for the following reasons:

1. The combination of Alexander and Hite does not teach or suggest all features of independent claim 28.

The prior art references, when combined, must teach or suggest all of the claim limitations. *See MPEP 2143.03.*

The Examiner states that Alexander teaches all portions of the claim except for “the specific memory structure of a queue to store the IPG and programming ads, as well as programming ads that are to be inserted in a programming avail.” However, Applicant

respectfully submits that Alexander fails to teach at least three additional elements of independent claim 28.

The Examiner notes that Alexander “discloses storing IPG ads..., the IPG ads being stored in an ordered list” (see page 3 of the Office Action). First, Applicant respectfully submits that this reading of Alexander is incorrect. Alexander does not teach, in the cited portion, that IPG ads are stored in an ordered list. Instead, Alexander teaches that “more than one virtual channel ad may be stored in RAM, but preferably only one such ad is displayed at a time” (column 5, lines 13-15). Items stored in RAM are inherently not stored in an ordered list, and there is no indication in Alexander that they are stored in an ordered list. On the contrary, items stored in RAM are stored in individual memory locations, independent of other memory locations. Thus, Alexander does not teach or suggest that the ads are stored in an *ordered list*.

It appears from the Examiner’s notation (see page four of the Office Action), “for displaying information in the virtual ad channel and ad window when a sports or news channel is selected, therefore, if a different channel is selected, different information in these areas are displayed and therefore, inherently reordered,” that the Examiner considers the grid guide (see column 5, line 6 of Alexander), the virtual ad channel, the EPG hard page, the PIP window, or the ad window that the user sees to be equivalent to an IPG ad queue. However, none of these features are equivalent to an IPG ad queue. An IPG ad queue is not a display itself, but instead a queue of IPG ads.

Moreover, Alexander teaches that an ad may be assigned a priority, such that the highest priority ad is displayed each time the same section of the EPG is displayed or entered (see column 26, lines 45-56 of Alexander). However, in Alexander the prioritized ads are not associated with the entire IPG, but rather is associated with only a specific page or section of the EPG. Thus, Alexander’s prioritization of ads cannot be considered an “IPG ad queue” as recited in independent claim 28, since an IPG ad queue is not associated with a particular page as described in Alexander, but instead is associated with the entire IPG.

Alexander also does not teach or suggest “displaying IPG ads...in accordance with the IPG ad queue.” Rather, Alexander teaches that when a particular item is shown in the EPG, a corresponding item is displayed according to a link between the items that has been previously established. For example, Alexander teaches that news items that are related are linked and then displayed together (column 19, lines 30-37). That is, in Alexander, a video is displayed in the PIP window because it is linked to the story that the user is reading. However, in the invention of independent claim 28, although IPG ads are linked with programming ads, the IPG ad is displayed “in accordance with the IPG ad queue.” This is significantly different than Alexander’s system, since Alexander teaches looking to the link between items to determine which item to display – not to the next item in a queue. Furthermore, Alexander cannot teach displaying an IPG ad “in accordance with the IPG ad queue,” because Alexander does not teach an IPG ad queue.

Since Alexander does not teach an IPG queue, Alexander also does not teach or suggest “reordering the IPG ad queue in accordance with the displayed programming ad.” Furthermore, the process described in column 19, Lines 13-37, of Alexander (cited by the Examiner as teaching reordering) does not teach or suggest the reordering of an IPG ad queue in accordance with the displayed programming ad. The Examiner states that Alexander teaches a method where the items displayed in the EPG are “inherently reordered” (Office Action, page 4). The Examiner interprets “inherently reordered” to mean that there is inherent reordering “if a different channel is selected, different information in these areas are [is] displayed.”

However, the process of displaying different information based on what channel is selected by the user is not the same as the process of reordering an IPG ad queue as recited in claim 28. Alexander’s process of displaying different information based on what channel is selected is analogous to correlating one item to another or using a look up table. That is, when one item is selected, Alexander’s system determines what other item correlates to or is linked with the selected item, and subsequently selects the correlated item for display.

In contrast, independent claim 28 recites that the queue of IPG ads is reordered according to the displayed programming ad. For example, if a queue contains IPG ads A, B, C in that order, changing the ad order within the queue to B, A, C, would be one example of “reordering” the IPG ad queue. Alexander, however, teaches that if an ad displayed in the Ad window is linked to PIP window ad A, then PIP window ad A is displayed. Alexander does not suggest any reordering after the display of an item. Thus, in Alexander, the priority of the ads A, B, C remains A, B, C. Applicant notes, however, that since Alexander does not focus on the order of linked EPG items, Alexander does not teach an order for linked EPG items at all. This is partially because Alexander does not teach a queue to begin with, but only a correlation table.

Additionally, although Alexander teaches that “ads can be assigned a priority...,” (column 26, lines 48-57) and be displayed according to that priority, Alexander never suggests that they are reordered nor that they are reordered in respect to the displayed programming ads. Furthermore, as submitted in Applicant’s previous response, the displayed programming ad refers to the “programming ads” in claim 28 and therefore is inserted or displayed “in a programming avail.” Alexander, however, discloses selecting an item to display in the EPG hard page based on another item that is displayed in the EPG hard page. Applicant respectfully submits that this selection process is not the same as or equivalent to reordering an IPG ad queue in accordance with the displayed programming ad. This is because a programming avail is not contained in the EPG hard page display. Thus, with respect to independent claim 28, Applicant respectfully submits that Alexander does not teach or suggest the features contended by the Examiner.

Accordingly, even if Alexander and Hite were combined as suggested by the Examiner, such combination still lacks the teaching of “storing IPG ads..., the IPG ads being stored in an ordered list,” displaying IPG ads “in accordance with the IPG ad queue,” and “reordering the IPG ad queue in accordance with the displayed programming ad,” since both Alexander and Hite are lacking these features. Accordingly, independent claim 28 is believed to be allowable over the combination of Alexander and Hite.

Similarly, independent claim 31 recites “storing IPG ads..., the IPG ads being stored in an ordered list,” displaying IPG ads “in accordance with the IPG ad queue,” and “reordering the IPG ad queue in accordance with the displayed programming ad.” For the same reasons discussed above with respect the independent claim 28, Applicant respectfully submits that the combination of Alexander and Hite, even if proper, does not teach or suggest all of the claimed features of independent claim 31. Accordingly, independent claim 31 is believed to be allowable of Alexander and Hite, taken either individually or in combination.

2. There is no motivation to combine Alexander and Hite.

When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. The Examiner can satisfy this burden only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant’s disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. *See Ex Parte Dussaud*, 7 U.S.P.Q.2d 1818, 1820 (Bd.Pat.App & Interf. 1988); MPEP 2143.01.

There is no motivation to combine Alexander and Hite, since Alexander teaches showing a particular ad window and PIP window combination based on the item in the EPG that is currently selected (column 19, lines 13-37), while Hite teaches showing a particular programming ad based on the profile of the user as stored in the “Consumer Database” (column 7, lines 20-29).

More specifically, Alexander (column 26, line 61- column 27, line 2) suggests that the advertisement displayed should be based on the advertisement displayed before entering the EPG. Alexander also suggests displaying a program (in the PIP window or ad window) based on the program related to the selected story, formatting the EPG based on the status of sporting events, and displaying a program related to the news story selected. Hite, however, teaches showing a particular programming ad based on the user profile, not the selection of a particular element of the EPG.

Although Alexander does teach using a user profile, such use is not in reference to the linking of the EPG and the PIP window or ad window. When referencing the EPG display, Alexander teaches a method of correlating or linking what is displayed in the EPG to what is displayed in the PIP window.

Due to these divergent teachings of Alexander and Hite, there is no motivation to combine the queue of Hite into the PIP window or ad window of Alexander, and those of ordinary skill in the art would not look to Hite to modify Alexander to result in Applicant's claimed invention.

3. If Alexander and Hite are combined, Hite changes the mode of operation of the primary reference.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01.

If Alexander and Hite are combined as suggested by the Examiner, the inclusion of Hite's features would change the mode of operation of Alexander. More specifically, Hite would change the mode of operation of Alexander in respect to choosing what item to display. Alexander discloses linking items in the EPG to other items in the EPG and choosing what item to display based on the link between the items. Hite discloses

displaying programming ads based on the user's profile. If Alexander were to choose what ad to display based on the user profile instead of based on the link, this would substantially change Alexander's mode of operation and the basic premise on which Alexander functions.

Applicant respectfully submits that the Examiner has not met the burden of *prima facie* obviousness, since the Examiner has not pointed to an objective teaching or combination of references which disclose Applicant's claimed invention and the motivation to combine them, combining the references would require a fundamental change in operation of the primary reference, and even assuming the references were properly combinable, not all of the limitations would be taught. Accordingly, Applicant respectfully submits that independent claims 28 and 31 are allowable over the suggested combination of Alexander and Hite.

Dependent claims 10, 12, 29-30, 32-33, 38 and 40 are allowable at least by their dependency on independent claims 28 and 31, respectively. Reconsideration and withdrawal of the Examiner's § 103(a) rejection of claims 10, 12, 28-33, 38 and 40 are respectfully requested.

The Examiner has rejected claims 2-3, 5, 34-35 and 37 as being unpatentable over Alexander in view of Hite and further in view of U.S. Patent No. 6,738,978 to Hendricks et al. ("Hendricks"). For the same reasons discussed above with respect to the Examiner's obviousness rejection over Alexander and Hite, independent claims 28 and 31 are believed to be allowable over the combination of Alexander and Hite. Applicant respectfully submits that Hendricks does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hite and Hendricks. Dependent claims 2-3, 5, 34-35 and 37 are allowable at least by their dependency on independent claims 28 and 31, respectively. Reconsideration and withdrawal of the Examiner's rejection of claims 2-3, 5, 34-35 and 37 are respectfully requested.

The Examiner has rejected claims 4 and 36 as being unpatentable over Alexander, Hite and Hendricks and further in view of U.S. Patent No. 5,283,639 to Esch (“Esch”). As discussed above, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hite and Hendricks. Applicant respectfully submits that Esch does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hite, Hendricks and Esch. Dependent claims 4 and 36 are allowable at least by their dependency on independent claims 28 and 31, respectively. Reconsideration and withdrawal of the Examiner’s rejection of claims 4 and 36 are respectfully requested.

The Examiner has rejected claims 11 and 39 as being unpatentable over Alexander and Hite and further in view of U.S. Patent No. 6,799,326 to Boylan III et al. (“Boylan”). As discussed above, independent claims 28 and 31 are believed to be allowable over the combination of Alexander and Hite. Applicant respectfully submits that Boylan does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hite and Boylan. Claims 11 and 39 is allowable at least by their dependency on independent claims 28 and 31, respectively. Reconsideration and withdrawal of the Examiner’s rejection of claims 11 and 39 are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the Examiner's rejections have been overcome, and that the application, including claims 2-5, 10-12 and 28-40, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: 3/17/06 By: Andrew W. Spicer
Andrew W. Spicer
Registration No. 57,420
Technology, Patents & Licensing, Inc.
2003 South Easton Road, Suite 208
Doylestown, PA 18901
Telephone: 267-880-1720
Facsimile: 267-880-1721

Customer Number **27832**